

1 **REMARKS**

2 Rejection of Claims Under 35 U.S.C. 112, Second Paragraph:

3 Claims 21 and 26 have been rejected under 35 U.S.C. 112, second
4 paragraph, as being indefinite for failing to particularly point out and distinctly claim
the subject matter, which the applicant regards as the invention.

5 Specifically, the Examiner states, "*a docking device* lacks positive
6 identification. It is not distinct whether the docking device is in fact part of the
7 claimed combination. Therefore, the docking device must be positively identified as
being part of the claimed combination of elements."

8 The Applicant notes that there are two separate requirements set forth in 35
9 U.S.C. 112, Second Paragraph:

10 (A) the claims must set forth the subject matter that the Applicant regards as
11 their invention; and,

12 (B) the claims must particularly point out and distinctly define the metes and
13 bounds of the subject matter that will be protected by the patent grant.
(MPEP 2171.)

14 A rejection based on failing to set forth the subject matter that the Applicant
15 regards as his invention is appropriate only where the Applicant has stated,
16 somewhere other than in the application as filed, that the invention is something
17 other than what is defined by the claims. In other words, the invention set forth in the
18 claims must be presumed, in the absence of evidence to the contrary, to be that
which the Applicant regards as his invention. (MPEP 2172(I).)

19 In regard to the requirement of particularly pointing out and distinctly defining
20 the metes and bounds of the subject, it is accepted that the Applicant can define in
21 the claims what he regards as his invention essentially in whatever terms he
22 chooses, so long as the terms are not used in ways that are contrary to the accepted
23 meanings in the art. (MPEP 2173.01.) The Applicant may use any style of
24 expression or format of claim which makes clear the boundaries of the subject matter
for which protection is sought. (Id.)

25 Basically, the acceptability of the claim language depends on whether one of
ordinary skill in the art would understand what is claimed, in light of the specification.
(MPEP 2173.05(b).)

1 The Applicant has not stated that the invention is something other than what
2 is defined by the claims, nor has the Applicant used terms in ways that are contrary
3 to the accepted meanings in the art. Additionally, one of ordinary skill in the art
4 would understand what is being claimed in light of the specification.

5 Furthermore, it is apparent that the Examiner is basing the rejection of claims
6 21 and 26 on the Applicant's use of a claim term "a docking device" that is not
7 recited as a claimed element. The Applicant contends that *it is clear* that "a docking
8 device" is not a claimed element, and that the Applicant has chosen to include that
9 term as a style of expression and/or format of claim which makes clear the
10 boundaries of the subject matter for which protection is sought.

11 Moreover, the Applicant is not aware of any legal precedent, including
12 holdings, statutes, regulations, rules and the like, which requires every term recited
13 in a claim to be positively identified as a claimed element. The Applicant, on the
14 contrary, contends that it is common for the Office to allow claims in which terms are
15 recited, but which are not positively identified as claimed elements, as in the manner
16 of the Applicant's claims 21 and 26.

17 Therefore, a rejection of the Applicant's claims based on failing to particularly
18 point out and distinctly claim the subject matter, which the Applicant regards as his
19 invention, is not appropriate.

20 Accordingly, for at least the reasons set forth above, the Applicant contends
21 that the claims, including claims 21 and 26, fully meet the requirements of 35 U.S.C.
22 112, second paragraph. The Applicant, therefore, respectfully requests that the
23 rejections of claims 21 and 26 under 35 U.S.C. 112, second paragraph, be
24 withdrawn.

25 Rejection of Claims Under 35 U.S.C. 103:

Claims 21, 24, 26-28, and 31 have been rejected under 35 U.S.C. 103(a) as
being unpatentable over U.S. Patent 6,731,455 to Kulakowski et al. ("Kulakowski") in
view of U.S. Patent 5,329,412 to Stefansky.

Specifically, the Examiner contends that Kulakowski discloses what the
Applicant claims in claims 21 and 26 except for the specifics of the HDD having a
"form factor in the shape of a tape cartridge." The Examiner contends further that,
"[i]t would have been obvious to one having ordinary skill in the art at the time the

1 invention was made to have the housing dimension of Kulakowski coincide with the
2 housing dimension of a magnetic tape cartridge, as taught by Stefansky since it has
3 been held that discovering an optimum value of a result effective variable involves
4 only routine skill in the art."

5 The Examiner also states that, "it would have been obvious for one of ordinary
6 skill in the art to have provided Kulakowski with a housing having the same
7 dimensions of a magnetic tape housing because such HDD cover had been known
8 in the art as demonstrated by Stefansky."

9 The Applicant respectfully contends that the Examiner has not established a
10 *prima facie* case of obviousness with respect to claims 21, 24, 26-28, and 31. A
11 *prima facie* case of obviousness requires that:

- 12 1) there must be some suggestion or motivation, either in the references
13 themselves or in the knowledge generally available to one of ordinary skill
14 in the art, to modify the reference or to combine the reference teachings;
- 15 2) there must be a reasonable expectation of success; and,
- 16 3) the prior art reference (or references when combined) must teach or
17 suggest all the claim limitations. (MPEP 2142.)

18 Firstly, the Examiner has not established that there is some suggestion or
19 motivation, either in the references or in the knowledge generally available to one or
20 ordinary skill in the art, to make the combination, as is required for a *prima facie* case
21 of obviousness.

22 Although the Examiner contends that, "it has been held that discovering an
23 optimum value of a result effective variable involves only routine skill in the art," the
24 Applicant counters with the assertion that combining the cited references is not
25 equivalent to discovering an optimum value of a result effective variable.

Furthermore, "legal precedent can provide the rational supporting
obviousness only if the facts in the case are sufficiently similar to those in the
application." (MPEP 2144.) The Applicant contends that the facts of *In re Boesch*,
which the Examiner cites and on which the Examiner relies, are not sufficiently
similar to those in the Applicant's application, and thus cannot be used in a rejection
of the Applicant's claims.

Also, as is noted above, the Examiner also contends that, "it would have been
obvious for one of ordinary skill in the art to have provided Kulakowski with a housing

1 having the same dimensions of a magnetic tape housing because such HDD cover
2 had been known in the art as demonstrated by Stefansky.” In response, the
3 Applicant notes that, “[a] statement that modifications of the prior art to meet the
4 claimed invention would have been ‘well within the ordinary skill of the art’ at the time
5 the invention was made’ because the references relied upon teach that all aspects of
6 the claimed invention were individually known in the art is not sufficient to establish a
7 *prima facie* case of obviousness without some objective reason to combine the
8 teachings of the references.” (MPEP 2143.01; emphasis added.) The Applicant
9 asserts that the Examiner has not provided an objective reason to combine the
10 teachings of the references.

11 Secondly, the Examiner has not established a reasonable expectation for
12 success when combining the cited references, as is required for a *prima facie* case
13 of obviousness. The Applicant notes that, “[i]f a proposed modification would render
14 the prior art invention being modified unsatisfactory for its intended purpose, then
15 there is no suggestion or motivation to make the proposed modification.” (Id.)
16 Furthermore, “[i]f the proposed modification or combination of the prior art would
17 change the principle of operation of the prior art invention being modified, then the
18 teachings of the references are not sufficient to render the claims *prima facie*
19 obvious.” (Id.)

20 The Applicant notes further that Kulakowski teaches that the hard disk
21 cartridge (2) is dual-ended, as is depicted in figure 1A of Kulakowski. That is,
22 Kulakowski teaches that the hard disk cartridge (2) has dual sets of data interfaces
23 (18), dual sets of power interfaces (26), and dual sets of gripper indentations (32a,
24 32b, 32c, and 32d), wherein one set is on one end of the cartridge and the other set
25 is on an opposite end. The dual-ended nature of the hard disk cartridge of
Kulakowski is essential to the principle of operation of the system disclosed by
Kulakowski. (See, for example, Kulakowski, col. 8, line 49 through col. 11, line 19.)

The dual-ended nature of the hard disk cartridge of Kulakowski is directly
contradictory to the cartridge of Stefansky. That is, Stefansky specifically teaches a
single-ended cartridge. Therefore, there is no reasonable expectation for success in
combining Kulakowski and Stefansky, because the proposed modification of
modifying the cartridge of Kulakowski to be single-ended as taught by Stefansky
would change the principle of operation of the prior art invention, and/or the

1 proposed modification would render the prior art invention unsatisfactory for its
2 intended purpose. That is, configuring the cartridge of Kulakowski in the manner of
3 the single-ended cartridge taught by Stefansky would render the system of
4 Kulakowski unsatisfactory for its intended purpose and/or would change the principle
of operation of the system of Kulakowski.

5 Thirdly, the Examiner has not established that the prior art references, when
6 combined, teach or suggest all of the claim limitations, as is required for a *prima*
7 *facie* case of obviousness. As stated in the MPEP, “[a]ll words in a claim must be
8 considered in judging the patentability of that claim against the prior art.” (MPEP
9 2143.03.) Specifically, the Examiner states that, “Stefansky discloses a portable
10 hard disk drive device [which] teaches that the hard disk drive device housing can
11 have the dimensions of a tape cartridge.” In fact, Stefansky actually discloses, at
12 most, “a single disk drive which ... conforms to the dimensions of a tape cassette
having a height of 0.6 inch.” (Stefansky, col. 1, lines 58-61.)

13 However, in claims 21 and 26, the Applicant does not claim “a hard disk drive
14 conforming to the dimensions of a tape cassette having a height of 0.6 inch.”
15 Rather, the Applicant claims, in part, “a housing and/or cartridge shell having a tape
16 cartridge form factor.” The Applicant defines “cartridge form factor” as “a set of
17 standardized physical configurational and dimensional criteria” (Applicants
18 specification at page 1, lines 29-30.) The Applicant asserts that “conforming to the
19 dimensions of a tape cassette having a height of 0.6 inch” is not equivalent to
20 “having a tape cartridge form factor.” Therefore, the cited prior art references do not
teach or suggest all of the elements and/or limitations of the Applicant’s claims 21
and 26.

21 The Applicant therefore contends, for at least the reasons set forth above, that
22 a *prima facie* case of obviousness has not been established for claims 21 and 26.
23 Accordingly, the Applicant respectfully requests that the rejections of claims 21 and
26 be withdrawn and the claims allowed.

24 In regard to claims 24, 27, 28, and 31, the Applicant notes that “[i]f an
25 independent claim is nonobvious under 35 U.S.C. 103, then any claim depending
therefrom is nonobvious.” (MPEP 2143.03.) Therefore, claims 24, 27, 28, and 31
are nonobvious for at least the reasons set forth above with respect to claims 21 and
26, because claims 24, 27, 28, and 31 depend from either claim 21 or claim 26.

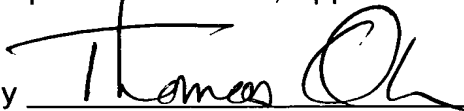
1 Accordingly, the Applicant respectfully requests that the rejections of claims
2 24, 27, 28, and 31 be withdrawn and that those claims be allowed.

3
4 **SUMMARY**

5 The Applicant believes that this communication constitutes a full and complete
6 response to the Office action mailed 09/29/2004, and the Applicant furthermore
7 requests timely allowance of claims 21, 24, 26-28, and 31. The Examiner is
8 respectfully requested to contact the below-signed representative if the Examiner
9 believes this will facilitate prosecution toward allowance of the claims.

10 Respectfully submitted,
11 Stephen Y. Deckers, Applicant

12 Date: December 27, 2004

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